

REMARKS

1. In Page 2, Paragraph 1 of the Office Action, the Examiner has requested an Information Disclosure Statement pursuant to 37 C.F.R. §1.98(b). Applicants note that an Information Disclosure Statement, Form PTO-FB-A820 and copies of the references were filed by Applicants' attorney on September 30, 2003. A stamped postcard in Applicants' attorney's files indicates that the U.S. Patent and Trademark Office received these documents on October 2, 2003.

The Examiner is requested to consider carefully the references provided with the Information Disclosure Statement in connection with the continued examination of the above-identified Application.

2. Claims 7-9 are being added to even more clearly show that which Applicants consider their invention. No new matter is added by these claims. Support for this Amendment is found, for example, at page 7, lines 28-32 of the specification. Therefore, entry of the new claims is respectfully requested.

3. Following entry of the new claims, claims 1-9 are now pending in the Application.

4. Claims 1, 3, 5-6 were rejected by the Examiner under 35 USC §103(a) on the basis that it would have been obvious to one of ordinary skill in the art to adjust the result-effective variables, such as column size, solvent composition and flow rate, in order to provide the desired separation results as was known in the art and to adjust the linear correlation between $\log P$ and $\log k'$ according to the new results. Applicants respectfully traverse this rejection.

Applicants submit that a prima facie obviousness rejection has not been established based on the teachings of the Minik et al. paper for the following reasons. First, while Minik et al. does disclose the use of a C18 column, the authors recommend using a C8 column as supported by their data. Note page 1928, column 1, paragraph 2 where it is stated "...C8 is the stationary phase of choice for modeling $\log P$ o/w." Thus one skilled in the art would not have been led to modify the C18 column as argued in the rejection. See In re Gurley, 31 USPQ2d 1130, 132 (Fed Cir. 1994). Second, it is submitted that the teachings of Minik et al. do not provide guidance to one of skill in the art as to what variables to specifically adjust to arrive at the equation of $\log D_{Oct}$ to $\log k'_w$ as taught by the Applicants. See In re Antonie, 195 USPQ 6,8 (CCPA 1977).

Applicants, therefore, respectfully request the Examiner to reconsider the Office Action and withdraw the rejection of the claims 1,3,5-6 under 35 USC §103(a).

5. Claims 1-6 were rejected under the judicially created Doctrine of Obviousness-Type Double Patenting as being unpatentable over Claims 1-8 of U.S. Patent No. 6,548,307. Applicants by their Attorney submit with this response a Terminal Disclaimer to moot the rejection of Claims 1-6 under the judicially created Doctrine of Obviousness-Type Double Patenting.

Applicants, therefore respectfully request the Examiner to reconsider the Office Action and withdraw the rejection of Claims 1-6 under the judicially created Doctrine of Obviousness-Type Double Patenting.

6. In view of the above remarks and documentation filed herewith, the Application and all of the claims are in condition for allowance and such favorable action is respectfully solicited. The Examiner is respectfully urged to contact the undersigned attorney for purposes of favorably advancing the prosecution of this Application.

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Respectfully submitted,



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